UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,153	07/31/2001	James O. Schreckengast	10004047-1	3204

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EXAMINER
WALSH, JOHN B

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/919,153	SCHRECKENGAST ET AL.
	Examiner	**Art Unit**	
	John B. Walsh	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>amendment of 6/6/2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>31 July 2001</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of invention I in the reply filed on June 6, 2005 is

acknowledged.

Drawings

2.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the features cited in the must be

shown or the feature(s) canceled from the claim(s). No new matter should be entered. The

drawings lack such a numerous amount of claimed features, that the examiner has only indicated

a few of the claimed features that are not found in the drawings (for example: claim 4 – decision

support software, planning services; claim 5 – health records; claim 6 – models associated with

troubleshooting products; claim 7- neural networks, influence diagrams; claim 8 – wireless

networks, cellular phones). The applicant should thoroughly review all of the claims and the

drawings to comply with this objection. Corrected drawing sheets in compliance with 37 CFR

1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number

of an amended drawing should not be labeled as "amended." If a drawing figure is to be

canceled, the appropriate figure must be removed from the replacement sheet, and where

necessary, the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement sheets

may be necessary to show the renumbering of the remaining figures. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as either

"Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not

accepted by the examiner, the applicant will be notified and informed of any required corrective

action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

Claim 1 recites an information utility, the language of the claim raises a question as to

whether the claim is directed merely to an abstract idea that is not tied to a technological art,

environment or machine which would result in a practical application producing a concrete,

useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. All

of the elements and features of the claim can be implemented in software alone, thus it does not

provide for tangible subject matter. Claim 19 recites a method. However, the language of the

method claimed raises a question as to whether the claim is directed merely to an abstract idea

that is not tied to a technological art, environment or machine which would result in a practical

application producing a concrete, useful, and tangible result to form the basis of statutory subject

matter under 35 U.S.C. 101. Also, the method does not produce a concrete result since if one of

ordinary skill performed the method repeatable results would not occur. Furthermore, the method

does not produce a tangible result since it does not require the use of any particular tangible

hardware or structure.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

6.   Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement. The claim(s) contains subject matter which was not described in

the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. The applicant's claimed

subject matter has not been described adequately in the specification to enable one skilled in the

art to make and use the invention. For example, the applicant has claimed an interface, however

there is no description of what and interface is and how it actually performs the functions

claimed. The specification seems to generally provide antecedent basis for the claim

terminology, however the lack of description of the components and functions of the claimed

subject matter does not provide for one skilled in the art to make and use the invention.

Furthermore as concerns claims 3, 4, 6, 7, 8, 9, 14 and 24, the claims provide a list of

technologies. However the specification, other then listing them by name, does not elaborate or

describe these technologies adequately in order to enable one skilled in the art to make and use

the invention. For example claim 3 recites "help identify patentable ideas". The specification

does not provide a description of how or what structure is "helping identify". The application

services are a function, the applicant has not provided a description of the structural make-up of

the application services, rendering it unclear how one skilled in the art can make and use the

invention.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

>   The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
>   subject matter which the applicant regards as his invention.

8.   Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

Claim 7 recites "are based on". The metes and bounds of the claim cannot be determined

since it is unclear if the technologies being listed are being claimed or if technologies based on

these technologies are being claimed. The examiner suggests the applicant delete the term "based

on".

(Note: As best understood, the claims are being rejected by prior art in order to further

prosecution in the event applicant's disclosure is corrected to comply with USC 101 and

USC 112)

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

>   A person shall be entitled to a patent unless –
>
>   (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
>   sale in this country, more than one year prior to the date of application for patent in the United States.

10.   As best understood, claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated

by Amazon.com.

As concerns claim 1, a proprietary information utility comprising: an interface (a computer) that provides outside entities connection to the proprietary information utility; a repository (storage medium storing the webpages and data) that contains proprietary information, wherein the repository is compartmentalized by user identity and entitlement, so that a first category of proprietary information is within private domains (private data) available to only a single user and a second category of proprietary information is within domains to which multiple users (public data) may be granted use in response to acquiring a license to use particular proprietary information within the second category of proprietary information; application services (searching the webpages); a security system (secure webpages and data), that limits access of each user connecting to the proprietary information utility to proprietary information to which each user is entitled, the proprietary information to which each user is entitled being accessed through use of the application services; and, a billing system (billing system for purchasing products/services from website) for tracking usage by users of the proprietary information utility for billing purposes.

As concerns claim 2, a proprietary information utility as in claim 1 wherein the second category of proprietary information includes decision support software (website runs off software).

As concerns claim 3, a proprietary information utility as in claim 1 wherein the application services include services to perform at least one of the following activities related to patents: help identify patentable ideas; create patent disclosures; manage pending patents; manage research logs; and, research existing patents (search for books on patents).

As concerns claim 4, a proprietary information utility as in claim 1 wherein the

application services include at least one of the services listed below: decision support software;

software for troubleshooting products; system configuration services; diagnostic services;

planning services; selection services; authoring tools that help authors generate appropriate

software models; learning services for data-mining and the ongoing evolution of models;

business intelligence services; version management services; presentation services; brokering

services; stock selection services; investment portfolio troubleshooting services; investment

portfolio selection services; services to troubleshoot devices; medical diagnosis services;

services that predict failure and behavior; purchasing decision services; consulting services;

skills gap analysis services; translation services for translating decision support models from

one underlying technology to another; enterprise resource planning services; and, customer

relationship management services (search for books on investment portfolio).

As concerns claim 5, a proprietary information utility as in claim 1 wherein the first

category of proprietary information contains health records and the application services

include services to provide services for supporting healthcare and patients, without revealing

private information (books on health in a users cart).

As concerns claim 6, a proprietary information utility as in claim 1 wherein the second

category of proprietary information includes proprietary information within at least one

of the areas listed below: decision support models; and, models associated with troubleshooting

products (books on decision support models).

As concerns claim 7, a proprietary information utility as in claim 1 wherein the second

category of proprietary information includes decision support models that are based on at least

one of the technologies listed below: Bayesian networks; neural networks; case-based systems;

model-based systems; rule-based systems; fuzzy systems; decision trees; genetic algorithms;

Monte Carlo Markov chains; clustering algorithms; Monte Carlo optimization; simulated

annealing; pattern matching; influence diagrams; online analytical processing; collaborative

filtering; linear programming; machine learning; and, time series (books on Bayesian networks).

As concerns claim 8, a proprietary information utility as in claim 1 wherein the interfaces

allows users to connect to the proprietary information utility using at least one of the following

deployment channels: wireless network; cellular phones; internet sites; applications embedded

in appliances; applications embedded in devices; applications embedded in vehicle

communication and information systems; applications embedded in intelligent agents; and,

applications embedded in memory modules (internet sites).

As concerns claim 9, a proprietary information utility as in claim 1 wherein the

application services include services to support the creation, maintenance, and deployment

of decision support models, in at least one of the following areas: data-mining; usage reports;

business intelligence reports; adaptive learning and refining of models; authoring wizards

particular to specific horizontal and vertical industries; and, quality benchmarks of models

(books on data-mining).

As concerns claim 10, a proprietary information utility as in claim 1 additionally

comprising: an application service registry that manages dynamic registration, access, use,

and disposal of the application services (site keeps of items viewed).

As concerns claim 11, a proprietary information utility as in claim 1 additionally

comprising: a proprietary information broker that maps semi-structured proprietary

information requests to a most appropriate proprietary information model and application

services that will operate on the most appropriate proprietary information model (website lists

related products to desired products).

As concerns claim 12, a proprietary information utility as in claim 1 wherein the security

system provides non-repudiation services in support of billing and reporting (billing information

entered on a secure site).

As concerns claim 13, a proprietary information utility as in claim 1 wherein the security

system provides privacy for all information transmitted outside of the proprietary information

utility, allowing proprietary services to make use of proprietary in formation utility without

revealing anything about users of the proprietary services and without revealing contents of data

moving between services (private data is secure not un-secure public data).

As concerns claim 14, a proprietary information utility as in claim 1 wherein the billing

system provides revenue to be generated using at least one of the following pricing schemes:

pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows;

subscription-based pricing; and, price bundling (subscription based pricing for a user ordering a

magazine subscription).

As concerns claim 15, a proprietary information utility as in claim 1 additionally

comprising: a scaleable computing engine that runs services across many pieces of

information (search engine for website).

As concerns claim 16, a proprietary information utility as in claim 1 additionally

comprising: a computing engine, the computing engine being used to translate information from

an author into a utility-native proprietary information format that can be used by a least a subset

of application services within the proprietary information utility (search terms entered into

search engine on website).

As concerns claim 17, a proprietary information utility as in claim 1 wherein the billing

system calculates royalty payments due to authors when proprietary information of the authors

is used by the application services within the proprietary information utility (authors receive

royalty payments based on books sold).

As concerns claim 18, a proprietary information utility as in claim 1 additionally

comprising an application service registry that manages dynamic registration, access, use,

and disposal of the application services, the application service registry providing a service

catalog, a discovery mechanism, and a brokering interface that links with the proprietary

information broker and the security system to provide a custom view of available application

services; based on entitlement and visibility (wish list or items in cart or items resulting from a

search).

As concerns claim 19, a method comprising the following steps: (a) providing outside

entities connection to a proprietary information utility (connect to website); (b) storing

proprietary information within a repository, wherein the repository is compartmentalized by

user identity and entitlement (memory storing data relating to users; wish list; items ordered);

(c) limiting access of each user connecting to the proprietary information utility to proprietary

information to which each user is entitled, the proprietary information to which each user is

entitled being accessed through use of application services operating within the proprietary

information utility (private data; users account), wherein multiple users can be granted access to

the same proprietary information (public users may access books and items sold on website, wherein a private user may buy the same products); and, (d) tracking usage of users of the proprietary information utility for billing purposes (users cart on website).

As concerns claim 20, a method as in claim 19 additionally comprising the following step: (e) managing dynamic registration, access, use, and disposal of the application services (user sets up an account).

As concerns claim 21, a method as in claim 19 additionally comprising the following step: (e) mapping semi-structured proprietary information requests to a most appropriate proprietary information model and application services that will operate on the most appropriate proprietary information model (website lists related products to desired products).

As concerns claim 22, a method as in claim 19 wherein step (c) includes providing non-repudiation services in support of billing and reporting (user enters payment info).

As concerns claim 23, a method as in claim 19 wherein step (c) includes providing privacy for all information transmitted outside of the proprietary information utility, allowing proprietary services to make use of proprietary information utility without revealing anything about users of the proprietary services and without revealing contents of data moving between services (private data transmitted securely, entered on a secure webpage).

As concerns claim 24, a method as in claim 19 wherein step (d) includes providing revenue to be generated using at least one of the following pricing schemes: pay-per-use micro-transactions; vendor-visible service-based pricing; hybrid flows; subscription-based pricing; and, price bundling (subscription based pricing for a user ordering a magazine subscription).

As concerns claim 25, a method as in claim 19 additionally comprising the following step: (e) translating information from an author into a utility-native proprietary information format that can be used by a least a subset of application services within the proprietary information utility (webpage presents text from books in another format for viewing on the webpage).

As concerns claim 26, a method as in claim 26 wherein step (d) includes calculating royalty payments due to authors when proprietary information of the authors is used by the application services within the proprietary information utility (author receives royalty payments based on number of books sold).

As concerns claim 27, a method as in claim 19 additionally comprising the following step: (e) providing a service catalog, a discovery mechanism to provide a custom view of available application services, based on entitlement and visibility (user can search by topic).

Response to Amendment

11.   The applicant has failed to list claims 28 and 29, which were cancelled, in the claims section.
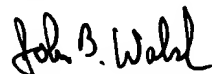
Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Wednesday from 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John B. Walsh
Primary Examiner
Art Unit 2151